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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/522,006

Filing Date: January 14, 2005

Appellant(s): PONCELET ET AL.

Andrew J. Anderson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 21, 2009 appealing from the Office
action mailed December 26, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,548,149

LIU, ET AL.

04-2003

(9) Grounds of Rejection

The following ground of rejection is applicable to the appealed claims:

Rejection under 35 U.S.C. §102(e)

Claims 1-3 and 5-19 stand rejected under 35 U.S.C. 102(e) as anticipated by the U.S. Patent of Liu et al. (6,548,149; hereinafter "Liu").

Liu teaches an ink jet recording element that contains a support and at least one ink-receiving layer (see Abstract; see also Column 5, Lines 33-53; see also Column 6,

Lines 18-28). In addition, Liu teaches that the ink-receiving layer comprises a hydrosoluble binder (i.e., polyvinyl alcohol) and an aluminosilicate polymer that is dispersed in the binder matrix (see Column 5, Lines 33-53; see also Column 6, Lines 18-28; see also Column 9, Lines 44-60; see also Column 10, Lines 46-56). Specifically, Liu provides that the aluminosilicate polymer that is present in the ink-receiving layer is such that it has an Al/Si molar ratio between 1 and 4 (see Column 9, Lines 44-60). In addition, Liu recites that the ink receiving layer, after printing, contains an amount of aluminosilicate particles that is from 50 to 100% by weight of the ink receiving layer and the additional ink-absorbent layer, which clearly meets the broad recitation of an amount between 5 and 95%, as in the present claim (see Column 15, Lines 42-57). In combining the aluminosilicate polymer with the suitable binder, it follows that Liu also provides that a coating composition for the ink-receiving layer is thus obtained.

Claims 1-3 and 5-16 are viewed as product-by-process claims and hence the methods that the aluminosilicate is created by are not pertinent, unless applicant can show a different product is produced, despite that fact that Liu recites that the inclusion of the aluminosilicate in the ink-receiving layer results in an ink jet recording material that has a high gloss, produces high quality printed images and has a good dye keeping time. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability

of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.”
In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

(10) Response to Argument

Appellant argues that it is erroneous to maintain that Liu anticipates the present claimed invention, because there is no reasonable basis for Examiner’s assertion that use of the aluminosilicate as prepared in Liu anticipates the use of the aluminosilicate polymers as specified in accordance with the present claimed invention. However, Examiner respectfully disagrees with Appellant’s assertion. The present claims are drawn to an article/product (“an ink jet recording element”) that comprises a support and at least one ink-receiving layer, where the ink-receiving layer comprises at least one hydrosoluble binder (e.g., gelatin or polyvinyl alcohol) and at least one aluminosilicate polymer that is obtained by the specified preparation method. Liu teaches an ink jet recording element that comprises a support and an ink jet receiving layer, and the ink jet receiving layer contains a polyvinyl alcohol binder an aluminosilicate polymer. Therefore, it can be reasonably concluded that the teachings of Liu teach a product that

matches that which is presently claimed, though the claimed invention is obtained by a process that is different from that which is taught in the references. Although Liu does not disclose that the aluminosilicate polymer that is obtained by the preparation method that is presently claimed, it is noted that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, “although produced by a different process, the burden shifts to application to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product.” *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). *See also*, MPEP §2113.

Appellant also argues that Examiner has failed to appreciate that Applicants have included evidence in the application as filed that the claimed product-by-process materials are identifiably different from other aluminosilicate polymers prepared by different processes, and in particular are different from other aluminosilicate polymers prepared by processes even closer to the claimed process than those employed in Liu.

Further, Appellant asserts that it is unjustified to require Applicants to perform even further testing of other materials prepared by such even further distinguished processes, as consideration of all of the evidence of record simply does not reasonably suggest that the material of Liu is necessarily identical to the material obtained in accordance with the claimed product-by-process materials. Examiner respectfully disagrees with Appellant's assertions. Appellant has demonstrated, through the Examples of the present application, that the present invention exhibits improved performance with respect to such properties as dye keeping and gloss for ink jet recording elements. However, Examiner has stated that the teachings of Liu recite that the inclusion of aluminosilicate in the ink-receiving layer results in an ink jet recording material that has a high gloss, produces high quality images, and has a good dye keeping time. Nevertheless, despite the similarity between the presently-claimed invention and the invention that is taught by Liu, and that fact that both inventions achieve enhancements in the same imaging properties, no direct comparison has been made between the aluminosilicate polymer that is presently claimed and that which is taught by the prior art of record. Appellant has not provided a comparative evidentiary showing that patentably distinguishes the claimed invention from the prior art of record. Instead, Appellant has relied upon the assertion that Applicants have included evidence that the claimed product-by-process materials are identifiably different from

other aluminosilicate polymers prepared by different processes, and in particular are different from other aluminosilicate polymers prepared by processes even closer to the claimed process than those employed in Liu, but to require that Applicants provide dispositive evidence that demonstrates the novelty of the claimed invention over the prior art is unjustified. Consequently, it remains unclear as to why the aluminosilicate polymer that is taught in the prior art is not encompassed by the polymer that is presently claimed.

Finally, Appellant argues that the references made to “or obvious” and “unobvious difference” is not understood, and Examiner has not alleged any prima facie case of obviousness with respect to the present claimed invention. In the present application, Examiner has alleged a case of anticipation of the present claimed invention by the teachings of the Liu reference. In support of Examiner's treatment of the present claims as being product-by-process claims, Examiner has provided Appellant with the pertinent language and citations to relevant case law that is on-point with the assessment of product-by-process claims. In the citation to *In re Thorpe*, the case recites that “[if] the product in the product-by-process is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”. As Examiner has made a rejection based on 35 U.S.C.

§102(e), asserting that the teachings of Liu anticipate that which is presently claimed, the relevant portion of the case citation is that "[if] the product in the product-by-process is the same as a product of the prior art, the claim is unpatentable even though the prior product was made by a different process". As is discussed hereinabove, Examiner has asserted that there is nothing in the portion of the claim that is directed to the claimed product (and not the product-by-process limitations) that positively recites an aluminosilicate polymer that is patentably distinguishable from that which is taught by Liu.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/David J. Joy/

Examiner, Art Unit 1794

Conferees:

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1794

/William A. Krynski/

QAS, Technology Center 1700